

## REMARKS

Claims 1-30 are pending

Claims 1-30 were rejected.

Claims 1-9 and 15-19 are amended herein. No new matter is added.

### REQUEST TO WITHDRAW FINALITY - PREMATURE FINAL REJECTION

Applicant respectfully submits that the final rejection of this application was improper. The Examiner indicated at page 2 of the March 3, 2008 Office Action that the new grounds of rejection were necessitated by Applicant's amendment. Applicant respectfully disagrees.

Applicant respectfully submits that it is improper to finally reject an application where Applicant's response did not include an amendment of all rejected claims, and wherein at least one non-amended claim is rejected on new grounds (newly cited reference of Batten). Applicant notes that the Office Action was issued in response to Applicant's Response, dated January 7, 2008, in which no amendment of original claim 8 was made. Original claim 8 remains pending. Applicant respectfully submits that the Examiner conducted a new patent search upon determining that Applicant's argument with respect to original claim 8 was found persuasive in overcoming the previous rejection. Because the new search was conducted as a result of Applicant's argument and the new grounds for rejection of original claim 8 were not made on the basis of any amendment made by Applicant, it is respectfully submitted that the final rejection dated March 7, 2008 is therefore improper.

In the event that the request to withdraw finality is not granted, Applicant is submitting a request for continued examination (RCE) and payment herein. Applicant reserves the right to petition the USPTO on the grounds that the present final rejection was improper.

### *In the Drawings*

FIG. 3 is amended to correct reference number 120 (was 110), as supported by and consistent with the description in paragraphs 0023 of the Specification.

### Claim Rejections - 35 U.S.C. § 102

The Examiner rejected claims 1, 3-6, 8, 10-22, and 24-30 under 35 U.S.C. § 102(e) over a newly cited reference of Batten, *et al.* (U.S. Patent 6,614,563).

The rejection is traversed. Previously presented claim 21 recites a scanning apparatus comprising:

- an original document plane;
- an optical scan module; and
- where the optical scan module is enabled to scan a transparent document by first performing a preview scan of the original document plane to obtain a distribution coverage of a plane light source, and subsequently performing a scan of a region within the distribution coverage of the plane light source to extract the image of the transparent document.

The newly cited reference of Batten describes a scanner including a flat panel illuminator disposed within the scanner lid that provides backlighting for scanning transparencies (Abstract). In rejecting claim 21, the Examiner referenced the panel illuminator 104 and transparency 106 of Batten as disclosing the plane light source and transparent document recited therein (see page 2, section 2 of the March 7, 2008 Office Action). The Examiner next identified Figures 1 and 2 and column 3 lines 19-46, apparently to disclose the distribution coverage and region recited by claim 21. The Examiner goes on to suggest that the entire claim 21 is disclosed by the reference at column 3 lines 19-46 in view of Figures 1 and 2. According to the reference at column 3 lines 19-46, a transparency 106 is scanned when an operator pushes a button on the scanner. The scanning operation of Batten is then described as passing a light 110 from the flat panel illuminator 104 through the transparency 106 onto a photosensitive transducer 114 which transforms the image into an electronic signal.

Applicant respectfully submits that the Examiner has failed to identify with sufficient specificity, what elements of Batten are being referenced as allegedly disclosing the various features of Claim 21. For example, the Examiner has not identified which elements in Batten have been interpreted to disclose the distribution coverage or region of claim 21. Furthermore, Applicant submits that the Examiner has failed to identify with any specificity, and in fact Batten fails to disclose, performing a preview scan and subsequently performing a scan of a region, as recited by claim 21.

Claim 21 recites performing a preview scan of the original document plane to obtain a distribution coverage of a plane light source. Even assuming that it is inherent that a light source

includes a distribution coverage, Batten fails to disclose performing any preview scan. In fact, Batten never once mentions the word preview. Applicant respectfully submits that the Examiner has failed to provide even a colorable argument that Batten discloses such a preview scan. Instead, the referenced section at column 3 lines 19-46 only describes a single scan of the transparency.

Claims 1 and 8 are believed to be allowable for similar reasons as provided above with respect to claim 21. Claims 3-6, 10-20, 22 and 24-30 are believed to be allowable as depending on claims 1, 8 or 21 as well as the further novel features recited therein.

Accordingly, withdrawal of the rejection of claims 1, 3-6, 8, 10-22 and 24-30 is respectfully requested.

### **Claim Rejections - 35 U.S.C. § 103**

The Examiner rejected claims 2, 7, 9, 14, and 23 under 35 U.S.C. § 103(a) over Batten in view of Haas, *et al.* (U.S. Patent 6,989,918).

The newly cited reference Haas describes a calibration window 98 to allow for sampling of light emitted from a light source 30 (col. 6 lines 34-37). Applicant respectfully submits that the light calibration fails to cure the deficiencies of Batten as described above. One skilled in the art would appreciate that a calibration window 98 of Haas fails to disclose performing a preview scan of the original document plane to obtain a distribution coverage of a plan light source. Rather the calibration window 98 is typically a small portion of the scanner platen that is used to calibrate a brightness or uniformity of the light source (see for example figure 2, item 114 and paragraph 0008 of Applicant's background section). Whereas Haas does describe a single instance wherein multiple frames of a film stock may be previewed, Haas fails to disclose performing a preview scan of the original document plane to obtain a distribution coverage of a plane light source, as recited by claim 21, or why it would be advantageous to do so.

As Haas fails to cure the deficiencies of Batten, claims 2, 7, 9 14, and 23 are believed to be allowable as depending on claims 1, 8 or 21 as well as the further novel features recited therein. Accordingly, withdrawal of the rejection of claims 2, 7, 9, 14 and 23 is respectfully requested.

### **Claim Amendments**

Whereas Applicant traverses the rejections of claims 1-30 for the reasons provided above, Applicant amends claims 1-9 and 15-19, and to expedite prosecution and without prejudice with regards to pursuing the claims as previously presented or in other forms in a continuation or other application. Support for the amendment of claims 1-9 and 15-19 may be found at Figures 3-5 as well as variously at paragraphs 0023-0028, 0031, 0032, 0035 and 0037, for example.

Any statements made by Examiner that are not addressed by Applicant do not necessarily constitute agreement by the Applicant. In some cases Applicant may have amended or argued the allowability of independent claims thereby obviating grounds for rejection of the dependent claims.

### **Conclusion**

For the foregoing reasons, reconsideration and allowance of the pending claims is requested. The Examiner is requested to telephone the undersigned at (503) 224-2170 if it appears that an interview would be helpful in advancing the case.

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Respectfully submitted,

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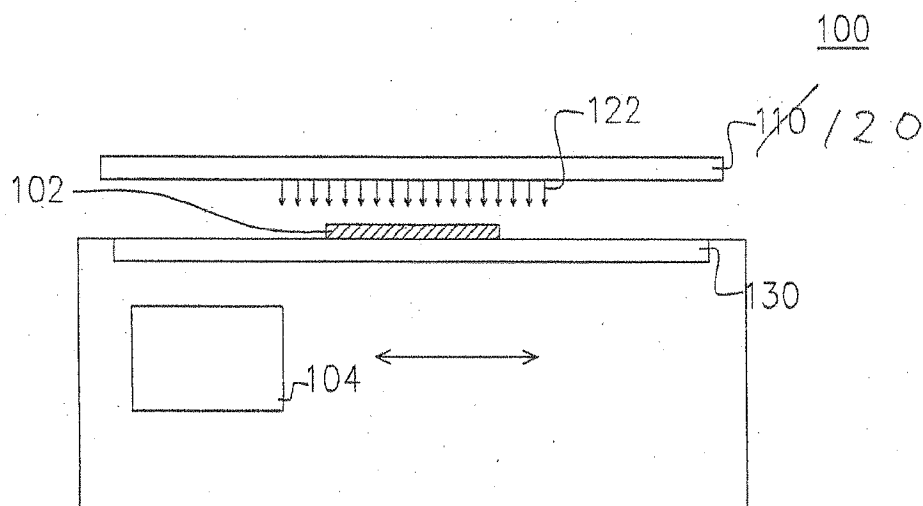


FIG. 3

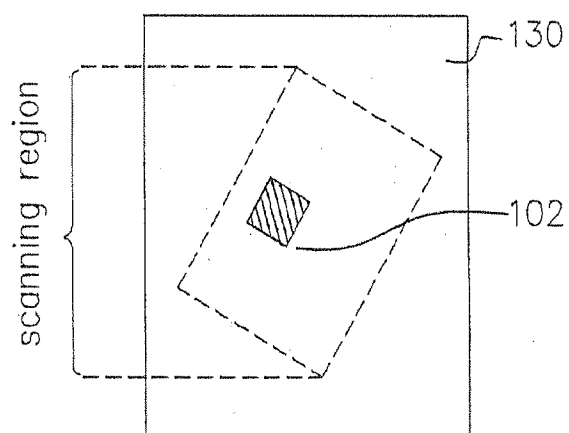


FIG. 4